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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/583,516	05/31/2000	MICHAEL L EMENS	AM9-99-0118	2490

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EXAMINER

ALVAREZ, RAQUEL

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 12/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/583,516

Applicant(s)

EMENS ET AL.

Examiner

Raquel Alvarez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 May 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. Claims 1-37 are presented for examination.

#### **Claim Rejections - 35 USC § 101**

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-5, 6-15 are non-statutory. Applicant has not given any process or any structural means for carrying out the invention. Applicant's invention is not implemented with any specific automated computer apparatus. Consequently, the claims are analyzed based upon the underlying process and thus rejected as being directed to a non-statutory process. the claims are not in the "technological" or "useful" arts, and the claims do not affect or define the technology. See *In re Toma*, 197 USPQ 852 (CCPA 1978).

Claims 1 and 22 are non-statutory, the claims do not produce a useful, concrete and tangible result. *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601-02.

Claims 32 and 34-37 are non-statutory, the claims define instructions for execution on a computer i.e. a computer program per se. A computer program per se does not define any structural and functional interrelationships that permit the computer program's functionality to be realized. It is for these reasons that the above claims are deemed to be non-statutory.

**Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-12, 15-20, 22-29, 31-35 rejected under 35 U.S.C. 102(b) as being anticipated by Skillen et al.(Wo 98/36366, hereinafter Skillen).

With respect to claims 1, 3, 4, 22 and 24, Skillen teaches a method for targeting based upon an information repository search by a user (Abstract). Associating an advertisement with a result from the information repository search (page 7, lines 16-25).

With respect to claims 2, 5 and 23, Skillen further teaches providing the advertisement on demand by said user (page 8, lines 12-22).

With respect to claims 6 and 26, Skillen teaches targeting related advertisements to individual search result items from a search of an information repository (Abstract and drawings). Matching said individual search result items to said related advertisements (page 7, lines 34-, page 8, lines 1-3).

With respect to claims 7-12, 27-29 Skillen further teaches submitting a query to said information repository and obtaining said individual search result items (page 7, lines 34, page 8, lines 1-3).

With respect to claims 16, 31 and 35 Skillen teaches providing related advertisements for search result items from a search of an information repository

(Abstract). Matching said search result items to said related advertisements (page 7, lines 34-, page 8, lines 1-3); designating each of said search result items that have said related advertisements matched herewith (page 7, lines 34-, page 8, lines 1-3); providing a corresponding graphical user interface for each of said search result items so designated for subsequent user selection (i.e. the user can click on the search results); searching and retrieving said related advertisements for one of said search result items when said corresponding graphical user interface is selected by the user (page 7, lines 34-, page 8, lines 1-3); and formatting and displaying said related advertisements upon selection (page 7, lines 34-, page 8, lines 1-3).

With respect to claim 15 and 19, Skillen further teaches that the user interface comprises a product icon (page 8, lines 12-22).

With respect to claim 17, Skillen further teaches assigning an identifier for said user when said user submits a query to said information repository (page 8, lines 12-22).

Claims 17, 18 and 20 are similar in scope as claims 9-12 and therefore rejected under similar rationale.

With respect to claim 25, Skillen further teaches displaying along with said search result a user-selectable icon containing a link to said associated advertisement (page 6, lines 35-, page 7, lines 1-9).

With respect to claims 32-34, Skillen further teaches formulating a list of the related advertisements and passing the list to the request server (page 9, lines 9-36).

**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 13, 14, 21 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Skillen.

With respect to claim 13, 21 and 30, the claims further recite an off-line batch process for identifying said related advertisements for said search result items. Skillen teaches on page 8, lines 23-33 maintaining a database of the search results for the users in order to find the best fit product advertisement for the user. Skillen doesn't specifically teach that the process is conducted off-line. Official notice is taken that off-line processing is old and well known. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included processing the information off-line because such a modification would allow for the information to be analyzed at a later time.

Claim 14 further recites providing a true/false designator to a user indicating whether said related advertisements exist for said individual search results items. Since, Skillen teaches advertisements based on the individual search results items (see abstract and drawings) then it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included providing a true/false to the user if said related advertisements exist because such a modification would give the

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users a definite response that advertisements based on the search criteria used does or doesn't exist.

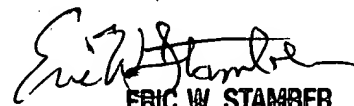
**Point of contact**

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (703)305-0456. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W Stamber can be reached on (703)305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9326 for regular communications and (703)872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.

R.A.  
December 15, 2002

  
ERIC W. STAMBER  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600